

REMARKS

The Official Action mailed March 4, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on February 20, 2004; October 11, 2005; October 30, 2006; May 8, 2007; July 20, 2007; December 2, 2008; and December 30, 2008.

A further Information Disclosure Statement was submitted on March 2, 2009, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 9, 11-14, 20-27 and 63-88 were pending in the present application prior to the above amendment. Claims 9, 11, 20-23 and 85-88 have been canceled without prejudice or disclaimer, claims 27 and 63-84 have been amended to better recite the features of the present invention, and new claims 89-113 have been added to recite additional protection to which the Applicant is entitled. The Applicant notes with appreciation the indication of the allowance of claims 12-14 and 24-27. Accordingly, claims 12-14, 24-27, 63-84 and 89-113 are now pending in the present application, of which claims 12, 24, 63, 67, 71, 75, 79, 103 and 108 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claim 23 under 35 U.S.C. § 112, second paragraph, as being indefinite and specifically asserting that "it is unclear how the flexible [integrated] circuit including flexible substrate is held between a first and second label when applicants drawings and specification describe the first label as the flexible substrate" (page 2, Paper No. 20090302). The Applicant has canceled claim 23 without prejudice or disclaimer; however, claim 27 previously recites similar features. Claim 27 has been amended to recite "wherein the flexible integrated circuit is held between a first label

and a second label, and the first label is affixed to the flexible integrated circuit with an adhesive," which is supported in the present specification, for example, by the paragraph bridging pages 12 and 13, which was corrected in the *Amendment* filed May 9, 2005 (received by OIPE May 12, 2005), and by Figure 4A. The Applicant respectfully submits that amended claim 27 particularly points out and distinctly claims the subject matter which applicant regards as the invention and is definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 63-73, 75-77 and 79-84 as anticipated by U.S. Publication No. 2003/0032210 to Takayama. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 63, 67, 71, 75 and 79 have been amended to recite an antenna provided on an interlayer insulating film. Also, claims 71 and 75 have been amended to recite a protective film covering the antenna. These features are supported in the present specification, for example, by elected Species 3 (Embodiment of Figure 4). The Official Action concedes that "the prior art fails to anticipate or render obvious the flexible integrated circuit with the limitations including an antenna provided on the interlayer insulating film" (page 8, Paper No. 20090302; emphasis added). Therefore, Takayama does not teach the above-referenced features of the present invention, either explicitly or inherently. Since Takayama does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 9, 11, 20, 21, 23, 74 and 78 as obvious based on the combination of Takayama and U.S. Publication No. 2004/0256644 to Kugler. The Official Action rejects claim 22 as obvious based on the combination of Takayama, Kugler and U.S. Publication No. 2002/0027247 to Arao. Claims 9, 11 and 20-23 have been canceled without prejudice or disclaimer; therefore, the above-referenced rejections of these claims are now moot. With respect to dependent claims 74 and 78, the Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Takayama. Kugler and Arao do not cure the deficiencies in Takayama. The Official Action relies on Kugler and Arao to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Kugler to allegedly teach a wiring and an antenna formed on the same surface (page 7, Paper No. 20090302), and on Arao to

allegedly teach a protective film of DLC provided on a thin film integrated circuit (page 8, Id.). However, Takayama, Kugler and Arao, either alone or in combination, do not teach or suggest that Takayama should be modified to include an antenna provided on an interlayer insulating film. Since Takayama, Kugler and Arao do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

At this opportunity, claims 63-84 have been amended so that the preambles are consistent with each other.

New claims 89-113 have been added to recite additional protection to which the Applicant is entitled. The features of claims 89-102 are supported in the present specification, for example, by page 13, lines 11-15 and 23-27. New independent claims 103 and 108 are similar to allowed independent claims 12 and 24 except that the feature of "a metal oxide" is removed. These claims are supported in the present specification, for example, by elected Species 3 (Embodiment of Figure 4). For the reasons stated above and already of record, the Applicant respectfully submits that new claims 89-113 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



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